



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,677	09/29/2000	Leo J. Campbell	8049.0001	1495

22852 7590 10/19/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/675,677	Applicant(s) CAMPBELL ET AL.	
	Examiner Christopher J. Brown	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-31 and 42-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-31 and 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/05/04, 8/30/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/12/2006 have been fully considered but they are not persuasive. The applicant has amended to include an additional unique value to the electronic message. Cook provides a unique transaction number in a message thus meeting the amended claim limitation.

Information Disclosure Statement

The IDS's submitted on 8/05/04, and 8/30/04 have been considered. Any documents that have not been considered were not considered because no copy of the document could be found.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 16, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite that "sending the digest, temporal stamp, and the digital signature to the electronic address as an electronic postmark, the electronic postmark includes a value that uniquely identifies the electronic postmark". It is unclear if the applicant intends to add an additional value, or the value included is one of the said digest, temporal stamp,

Art Unit: 2134

or digital signature, all of which are unique. The examiner is proceeding under the assumption that the applicant intends to add an additional value. Appropriate correction is required. All claims dependent on said rejected independent claims are also rejected.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9, 10, 11, 12, 15, 16, 18, 19, 20, 22, 25, 26, are rejected under 35

U.S.C. 103(a) as being unpatentable over Byrd US 6,081,899 in view of Rubin

US 5,638,446 in view of Cook US 6,675,153.

As per claim 1, 2, 4, 8, 10, 11, 12, 15, 16, 18, 19, 20, 22, 25, and 26 Byrd

discloses a method for authenticating and electronic message (Col 2 lines 6-7).

Byrd discloses a client (user) creating a message, (Col 4 lines 32-34) and sends

the message to be authenticated by a server appending a timestamp and digital

signature (Col 2 lines 25-27, Col 4 lines 16-22). Byrd discloses the message is

forwarded to the recipient, (Col 4 lines 40-45). Byrd discloses that the recipient

authenticates the stamp and signature, (Col 2 lines 30-33, Col 4 lines 45-50).

Byrd does not teach creating a digest. Byrd does not teach a log. Byrd does not

teach sending an account number and attaching the payment to a digest.

Cook teaches a unique account number is sent with a message, (Col 7 lines 58, 61 Fig 2: transaction number). Cook teaches appending a time stamp and payment to a digest, including the transaction amount (Col 7 lines 45-63).

It would have been obvious to one of ordinary skill in the art to include the unique items of Cook with the message authentication of Byrd because the payment information helps to keep records and enhance the security of a transaction system (Col 3 lines 26-55).

Cook teaches a log containing a record of a message exchange including digital signatures, timestamps, and other authentication data, (Col 16 lines 35-40).

It would be obvious to one skilled in the art to add the log of Cook to the message system Byrd because the log provides for accountability and tracking when needed.

Rubin discloses a user creating a digest (hashing) and sending an electronic file to a third party for authentication. Rubin discloses that the third party digitally signs the hash in the creation of a certificate, (Col 3 lines 15-23).

It would be obvious to one skilled in the art to add the method of hashing from Rubin with the Third party timestamp, signature, and log of the Byrd-Lloyd combination because the one-way hash allows the third party and recipient to check for tampering.

Art Unit: 2134

As per claim 3, Byrd discloses the timestamp indicates when the message was received, (Col 4 line 18).

As per claim 5, Byrd teaches that the message may be email, (Col 4 line 33). It is inherent in email that the electronic address included is that of the sender.

As per claim 6, Byrd discloses attaching at least one legal protection of an official entity (Verisign), (Col 3 lines 16-25).

As per claim 9, Byrd discloses authenticating the digital signature and authentication data, (Col 2 lines 30-35).

As per claims 17 and 21 Byrd discloses the use of the Internet (Col 4 line 6) it would be obvious to one skilled in the art to use TCP/IP.

Claims 13, 14, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd US 6,081,899 in view of Rubin US 5,638,446 in view of Cook US 6,675,153 on view of X.509

As per claims 13, 14, 23, and 24 the Byrd-Cook-Rubin combination does not explicitly teach including a digital key with a digital signature and using that key to authenticate the digital signature.

Byrd discloses that the message is sent with a certificate, (Col 4 line 2).

X.509 discloses that the X.509 certificate standard is widely accepted and that the certificate contains the subject's public key.

It would be obvious to one skilled in the art to use the X.509 standard because it is widely used, secure and flexible.

Claims 27-31, and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd US 6,081,899 in view of Rubin US 5,638,446 in view of Cook US 6,675,153 in view of Murray US6,321,333

As per claims 27-31, 42-46 Byrd discloses a method for authenticating and electronic message (Col 2 lines 6-7). Byrd discloses a client (user) creating a message, (Col 4 lines 32-34) and sends the message to be authenticated by a server appending a timestamp and digital signature (Col 2 lines 25-27, Col 4 lines 16-22). Byrd discloses the message is forwarded to the recipient, (Col 4 lines 40-45). Byrd discloses that the recipient authenticates the stamp and signature, (Col 2 lines 30-33, Col 4 lines 45-50).

Byrd does not disclose creating a digest. Byrd does not disclose exporting a public key for authorizing.

Cook teaches a unique account number is sent with a message, (Col 7 lines 58, 61 Fig 2: transaction number). Cook teaches appending a time stamp and payment to a digest, including the transaction amount (Col 7 lines 45-63).

It would have been obvious to one of ordinary skill in the art to include the unique items of Cook with the message authentication of Byrd because the payment information helps to keep records and enhance the security of a transaction system (Col 3 lines 26-55).

Cook teaches a log containing a record of a message exchange including digital signatures, timestamps, and other authentication data, (Col 16 lines 35-40).

Art Unit: 2134

It would be obvious to one skilled in the art to add the log of Lloyd to the message system Byrd because the log provides for accountability and tracking when needed.

Rubin discloses a user creating a digest (hashing) and sending an electronic message to a third party for authentication. Rubin discloses that the third party digitally signs the hash in the creation of a certificate, (Col 3 lines 15-23).

It would be obvious to one skilled in the art to add the method of hashing from Rubin with the Third party timestamp and signature of Byrd and log of Cook, creating an electronic postmark because the one-way hash allows the third party and recipient to check for tampering.

Murray discloses getting a digital public key authorized by a certificate authority, (Col 4 lines 1-9).

It would be obvious to one skilled in the art to modify the Byrd-Cook-Rubin combination with the authorized public key of Murray because the certificate authority is a mutually trusted entity so that the recipient of the key knows the key is trustworthy.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eggleston US 5,764,899 teaches a unique serial number used in an email in addition to a hash and other unique identification

Art Unit: 2134

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

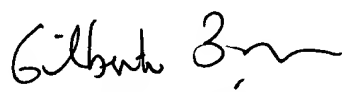
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jaques Louis Jaques can be reached on (571)272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher.J.Brown

10/11/06



GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100